

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

09952.0033

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on _____

Signature _____

Typed or printed
name _____

Application Number

10/578,087

Filed

May 3, 2006

First Named Inventor

Mauro SENTINELLI

Art Unit

2431

Examiner

Zia, Syed

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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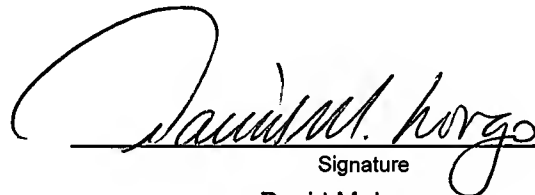
attorney or agent of record.

Registration number 53,235

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

David M. Longo

Typed or printed name

(571)203-2763

Telephone number

August 26, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--------------------------------|-------------------------|
| In re Application of: |) |
| |) Group Art Unit: 2431 |
| Mauro SENTINELLI |) |
| |) |
| Application No. 10/578,087 |) Examiner: Zia, Syed |
| |) |
| Filed: May 3, 2006 |) |
| |) Confirmation No. 4710 |
| For: METHOD AND SYSTEM FOR THE |) |
| AUTHENTICATION OF A USER OF A |) |
| DATA PROCESSING SYSTEM |) |

Mailstop: AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Requirements for Submitting a Pre-Appeal Brief Request for Review

Applicant has met each of the requirements for this submission and therefore requests review of the Examiner's rejections in the Final Office Action mailed on April 28, 2011, for the following reasons. This application has been rejected at least twice. Applicant has concurrently filed a Notice of Appeal. Applicant submits this Pre-Appeal Brief Request for Review setting forth legal or factual deficiencies in the rejections in five (5) pages or less. *See* Official Gazette Notice, July 12, 2005.

II. Claim Status and Summary of Final Office Action

Claims 33-51 and 53-62 remain pending in this application. In the Final Office Action, the Examiner withdrew the rejection of claims 47 and 51 under 35 U.S.C. § 101, but maintained the rejection of claims 60-62 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and maintained the rejection of claims 33, 35-45, 47-49, 51, 53, 54, and 56-62 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0055738 ("*Alie*"). In addition, the Examiner objected to the specification as failing to provide antecedent basis for the claimed subject matter. Finally, the Examiner indicated that claims 34, 46, 50,

and 55 contain allowable subject matter, and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

III. The Rejection of Claims 33, 35-45, 47-49, 51, 53, 54, and 56-62 under 35 U.S.C. § 102(e) is Legally Deficient

The rejection of claims 33, 35-45, 47-49, 51, 53, 54, and 56-62 under 35 U.S.C. § 102(e) is legally deficient because the Examiner (1) has not responded to the arguments presented in the Amendment filed on January 26, 2011; and (2) has not shown that each and every element as set forth in the claim is found, either expressly or inherently described, in *Alie*. Regarding (1), *see* M.P.E.P. § 707.07(f) (“[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (emphasis added).) Regarding (2), *see* M.P.E.P. § 2131; *see also* *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1362, 1371 (Fed. Cir. 2008) (holding that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102”).

First, in the “Response to Arguments” section of the Final Office Action, the Examiner alleged that *Alie* discloses the features of Applicant’s claims by restating *Alie*’s disclosure at, for example, paragraphs [0010]-[0018], [0048]-[0051], and [0070]-[0096]. *See* Final Office Action, pages 3-5. However, the Examiner did not address the arguments presented against these allegations in the Amendment filed on January 26, 2011. In fact, the reasoning in the “Response to Arguments” section (beginning with the text “This is not found persuasive”) is exactly the same as that in the last Office Action dated October 26, 2010. *See* Final Office Action, page 3, last paragraph to page 5, second paragraph, which is the same as the October 26, 2010 Office Action, page 3, second paragraph to page 4, last paragraph.

Specifically, the Examiner did not respond to the arguments regarding, for example, the “second subscriber identity module” and “second authentication” presented in the January 26, 2011 Amendment (*see, e.g.*, pages 10-11), which responded, in particular, to the allegations in the “Response to Arguments” section of the October 26, 2010 Office Action. In the Final Office Action, the Examiner even stated that “Applicant’s arguments filed on August 13, 2010 have been fully considered ...” (page 3, first paragraph, emphasis added), however, the Examiner should have indicated his consideration of the Amendment filed on January 26, 2011. The Examiner thus ignores the merits of Applicant’s response filed on January 26, 2011, in which Applicant explicitly pointed out the claim features not disclosed by

Alie. See Amendment filed on January 26, 2011, pages 9-11. Therefore, the finality of the Office Action is improper and should be withdrawn, and the rejection itself is legally deficient.

Second, in the “Response to Arguments” section, the Final Office Action alleged that *Alie*’s smart card (hardware secure module) with encryption keys that calculates a response using an ID code constitutes claimed “first subscriber identity module.” See Final Office Action, page 3. The Final Office Action then alleged that either the same hardware secure module “with encryption keys for processing information and calculating the response” or “an interface for displaying information and prompting the end user for the identification code (PIN) and means for inputting the identification code” constitutes the claimed “second subscriber identity module.” *Id.* (It is not clear from the Final Office Action which one of the above two entities is referred to when discussing the disclosure of the “second subscriber identity module.”) If the Final Office Action refers to the “hardware secure module,” it is clear that such hardware secure module would be the same device the Final Office Action alleged as the “first subscriber identity module.” If, on the other hand, the Final Office Action refers to the “interface” and/or “means for inputting the identification code,” Applicant points out that neither of the two entities constitutes the claimed “second subscriber identity module” at least because they are merely input/output devices that facilitate the authentication performed by the “hardware secure module.” They cannot perform any authentication process by themselves.

Moreover, the Final Office Action alleged that *Alie*’s “approving the transaction” discloses the claimed “second authentication.” Final Office Action, page 3. This is incorrect. First, such “approving” is in response to the input ID code, which is part of the authentication process performed by the “hardware secure module,” not a separate authentication. Second, the “approving” is clearly not performed by the inputting means, therefore cannot constitute “said second authentication being based on identification information provided to the user at the mobile communication terminal through the mobile communication network using a second subscriber identity module,” as recited in claim 33 (emphases added).

Therefore, *Alie* discloses only one SIM used in a user’s personal mobile device. See *Alie*, Figs. 12-14. See also *Alie*, paragraph [0092]. The SIM in *Alie*’s system is only provided in the mobile handset (see *Alie*, Fig. 12, reference number 1205 and 1204) and there is only one authentication process between the server and the mobile handset using the SIM. See *Alie*, Figs. 6, 7a, 7b, and 8. Thus, *Alie* does not disclose or suggest the claimed “a second subscriber identity module” and/or “a second authentication,” as recited in amended claim 33 (and similarly

in claims 44, 48, 53, and 60). The rejection is therefore legally deficient and should be withdrawn, because the Examiner (1) has not responded to the arguments presented in the Amendment filed on January 26, 2011; and (2) has not shown that each and every element as set forth in the claim is found, either expressly or inherently described, in *Alie*.

IV. The Rejection of Claims 60-62 under 35 U.S.C. § 101 is Factually Deficient

The Final Office Action alleged that the “authentication kit” recited in claims 60-62 is “interpreted as software per se.” *See* Final Office Action, pages 5-6. Applicant disagrees and notes that independent claims 60 and 62 both recite that the “authentication kit” comprises “a hardware computer peripheral device” (emphasis added). Therefore, the claimed “authentication kit” is not software per se, and the rejection is factually deficient and should be withdrawn.

V. The Objection to the Specification is Legally Deficient

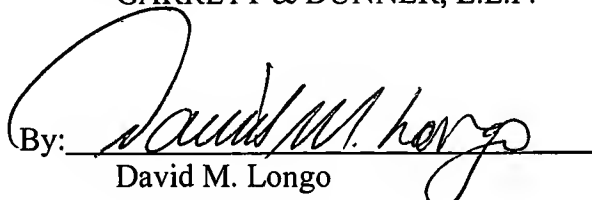
Further to the appealable issues raised above, Applicant also requests that the panel of examiners remove the objection to the specification at this pre-appeal stage. The Final Office Action objected to the specification as “failing to provide antecedent basis for the claimed subject matter.” *See* Final Office Action, page 2. While Applicant acknowledges the explanation in M.P.E.P. § 608.01(o), Applicant notes that the specification does not always have to provide literal “antecedent basis” for claim(s), but instead must “clearly support” the claim(s). In this case, the specification does clearly support the claims at, for example, page 10, lines 4-10, which recites “computer readable storage media.” Here, there is “clear support” in the specification for the claimed non-transitory computer readable medium, “so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 C.F.R. § 1.75(d)(1). Therefore, the objection to the specification is legally deficient and should be withdrawn at this pre-appeal stage.

VI. Conclusion

Therefore, the rejections and objection are legally and/or factually deficient should be withdrawn. Claims 33-51 and 53-62 should be allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
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Reg. No. 53,235

Dated: August 26, 2011